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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,535	01/24/2001	Robert J. Schena	9469-4 DI2	3002

7590 06/24/2003  
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EXAMINER

HOLZEN, STEPHEN A

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/768,535

Applicant(s)

SCHEMA ET AL.

Examiner

Stephen A. Holzen

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,6,8,9 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. This application appears to be a division of Application No. 09/310,355, filed 05/12/1999. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure, which is germane to the invention as claimed in the divisional application.

***Preliminary Amendment***

2. Receipt is acknowledged of the preliminary amendment, canceling claims 1-20, and 30-36. Claims ~~21~~-29 are pending in the case.

***Information Disclosure Statement***

3. The information disclosure statements filed on 1/24/01, 7/25/02, 1/21/03, and 5/14/03 have been received and entered into the case. All references there in have been considered with the exception of Reference #BB in the IDS filed on 1/24/01. The applicant is requested to check Reference #BB because the patent # and applicants name do not match.

***Drawings***

4. The drawings are objected to because they fail to show necessary textual labels of features or symbols in Figures 1-4 as described in the specification. For example, place a label "Scanner", with element 100 of figures 1-4 would give the viewer necessary detail to fully understand this element at a glance. A descriptive textual label for each numbered element in these figures would be needed to better understand these figures without substantial analysis of the detail specification. Any structural detail that is of sufficient importance to be described should be labeled in the drawing. Option the applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.84(n)(o)

5. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

6. The abstract of the disclosure is objected to because, in light of the cancellation of the bulk of the originally submitted claims, the abstract no longer reflects the invention cited in the remaining claims.

Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant cannot have an "optional" claim. The examiner does not understand this limitation. Is the user information inputted or not? For the purposes of this examination the examiner has assumed that the claimed method includes the step of "obtaining and storing a user input information."

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 21-27 rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al (5,969,324). Reber et al discloses a method of commercial administration using a network connecting a scanner, a portal server, and a receiver, the method comprising the steps of generating a written record of a transaction, which record includes machine-readable code identifying at least the transaction and a database containing records of the transaction and accessible from the network via the portal server (see Abstract),  
scanning said machine-readable code using the scanner (#54)  
storing the machine - readable code in a memory (#50)  
optionally obtaining and storing a user input information (see Col. 6, line 6)  
sending the stored information and information identifying the user to the portion server via the network, receiving the information at the portal server, and accessing the records of the transaction in the said database. (see Col. 5, lines 26-32)

Re - Claim 22: which comprises downloading from the database to the receiver the records of the transaction (see Col. 5, lines 26-32)

Re - Claim 23: wherein the written record is a receipt (abstract) and which comprises importing the downloaded records into an expense accounting system (see Col. 5, lines 30-32)

Re - Claim 24: Which comprise automatically transferring funds to pay a debt created by the transaction (see Col. 5, lines 30-32\_

Re - Claim 25: appending user information (see Figure 9 and Col. 6, line 6)

Re - Claim 26: wherein the transaction is a sale and the database contains product and purchaser information (see Abstract, Col. 6, lines 1-10)

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber in view of Cragun et al (5,804,803). Reber teaches every aspect of the present invention except which comprise using the product and purchaser information for warranty administration for maintenance contract administration and supply of upgrades. Cragun et al teaches that it is well known and old in the art to supply information related to warranty, maintenance and upgrades on the product in the form of a bar code. (see Col. 4, lines 1-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to encode warranty, service and upgrade information on the receipt (instead of on the product itself) to allow for a more aesthetically pleasing design.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Cragun et al teaches an information gathering system where users can use the Internet to find products/information, which they are interested. They can view price, size, weight, instruction, application, view a demonstration, service information, background, service producers, manufactures and sellers
- b. O'Brien et al (5,832,457) discloses a system having a customer database, a network, where when a purchaser takes a product to a cashier the user is identified and the software determines if the customer qualifies for coupons. Further the database software will recognize the coupon redeemed and means for maintaining a log of coupons printed and redeemed.
- c. Roslak (5,825,002) teaches a scanner used for scanning items in a store for self-check out purposes. Retains a database of customer information (name, address, credit histories, and updates the data base at every opportunity. Inherently the store has access to the database of referencing files.
- d. Doyle teaches that it is well known to generate a record of transaction (invoice) and deliver this invoice to a customer. And further teaches that it is well known to keep a database of user information, shipment tracking, invoices, catalog items, upgrades.
- e. Scroggie et al demonstrates tracking and recording purchase history. Tracking and storing purchaser information transmit a rebate to the consumer. The rebate has a bar code on it. The bar code refers to the transaction. The bar code is scanned and the producer/seller verifies that the rebate is for the purchaser and provides the rebate earned. Obviously a receipt is required with



a rebate. It generates a written record (rebate) a machine readable code (bar code) scanning, user input (address, name email) receiving sending to the portal (checking for validity) accessing the records (double checking for validity)

f. "43 Ways Computer Can Help you": teaches that computer can be used for report processing and tied with the purchasing functions.

g. Hudetz (WO 97/01137): Teaches that it is known to read UPC codes with a barcode scanner, and to link users directly to a product specific website.

h. Shachar (6,012,102): teaches machine-readable symbols (MRS), and linking the MRS to data resources (databases, network links, world wide web).

i. Zetmeir (4,752,675); teaches using Machine-readable Code to gather data on buyers.

j. Rhoads (6,311,214): read steganographic encoding and links users directly to the object on-line.

k. McGaha (5,278,396): reads a barcode (Machine Readable Code) and looks up price, personal information, return information (warranty).

l. Mares (2002/0095344 A1): a method of accounting and auditing financial transactions, assigning each transaction a number, the number references to customer, amount of transfer, type of transaction the date and the point of sale site, and all info saved in a database.

m. Reber et al (6,484,943 B1): Reber et al discloses a machine-readable code, a scanner, and links the code to a URL, and assigns each URL a priority.

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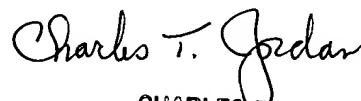
n. Reber et al (6,412,695): Reber et al discloses that it is know to encode data within a bar code.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A. Holzen whose telephone number is 703-308-2484. The examiner can normally be reached on M-F 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles T. Jordan can be reached on 703-306-4159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4174.

Sah  
June 19, 2003



CHARLES T. JORDAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

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